REMARKS

Claims 1-16 are pending in this application. Claims 1 is the only independent claim. Reconsideration in view of the following remarks is respectfully solicited.

Allowable Subject Matter

Applicant notes with appreciation the indication on page 10 of the Office Action that claims 6-8 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, Applicant respectfully submits that this is not necessary in view of the following remarks.

The Claims Define Patentable Subject Matter

The Office Action rejects:

(1) Claims 1-5 and 13-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent No. 11127211 A to Matsuura (hereafter Matsuura) in view of U.S. Patent No. 5,155,453 to Ruetz (hereafter Ruetz); and

(2) Claims 9-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Matsuura in view of Ruetz and further in view of Publication No. 2004/0166799 to Kral (hereafter Kral).

These rejections are respectfully traversed.

Applicant respectfully submits that the claimed invention is distinguishable from the combination of Matsuura and Ruetz for at least the following reasons:

In response to our previous arguments, the Examiner indicates that our arguments have been considered but they are not persuasive. Specifically, the Examiner alleges that if the oscillator 50 of Matsuura was replaced with the Ruetz's dual mode oscillator, terminal 35 in

Matsuura's Fig. 1 would be able to generate an output of two different frequencies. Applicant respectfully disagrees with this allegation.

For example, Applicant submits that if Ruetz's dual mode oscillator replaced Matsuura's oscillator 50, Matsuura's down converter circuit 58 would not function properly. For instance, Matsuura's oscillator 50 is a fixed oscillator circuit. As such, it goes to follow that Matsuura's low pass filter 51 must be set to pass a predetermined frequency. As a result, if Ruetz's dual mode oscillator was inserted into Matsuura's down converter circuit 58, and took the place of the oscillator 50, the low pass filter 51 would be inoperable for at least one of the modes of the dual mode oscillator because it is clearly based upon a fixed oscillator not a dual mode type. Thus, Matsuura's output terminal 35 would not see two different frequency bands as suggested by the Examiner in part because Matsuura's low pass filter is not designed for such an output.

Under U.S. patent law, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon,* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Applicant submits that if Matsuura was modified as suggest by the Examiner, Matsuura's down converter circuit 58 would be unsatisfactory for the Examiner's intended purpose, i.e., to have two output frequencies.

Furthermore, the Examiner still alleges that Matsuura's down converter includes both circuit 58 and circuit 47. (see Office Action, page 4). Applicant disagrees with this allegation.

For example, Matsuura clearly discloses that circuit 58 is stored in den 70, a separate den from circuit 47. (see Matsuura, paragraph [0037]. As such, Matsuura's circuit 58 clearly does not include circuit 47. As such, the Examiner is improperly characterizing Matsuura's down converter as including both circuit 58 and circuit 47 when it clearly does not.

Kral Fails to be Prior Art

Furthermore, Applicant submits that both Matsuura and Ruetz fail to teach or suggest a low pass filter that outputs two different frequency bands. In an attempt to show such a feature, the Examiner imports Kral. However, Kral must be removed as prior art. In other words,

Applicant has perfected filing of the priority document by filing an English language translation thereof. As such, because the effective filing date of Kral, e.g., November 29, 2000, fails to predate our priority date of February 14, 2000, Kral must be removed as prior art.

Furthermore, the Examiner has failed to show each and every feature in the combination of Matsuura and Ruetz and the Examiner is attempting the paste features from two different references together to arrive at the claimed invention, without providing proper motivation for doing the same and without showing whether such a modified configuration is even feasible for Matsuura.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that the examiner has failed to establish a *prima facie* case of obviousness at least in part because the examiner has failed to show how each and every feature is taught by the cited art.

Applicant respectfully submits that the examiner has failed to show any suggestion or motivation from either the references themselves or in the knowledge generally available to one of ordinary skill in the art why it would be proper to combine the cited references. Instead, the Examiner is merely relying on improper hindsight.

Applicant respectfully submits that the combination of cited art fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicant respectfully submits that independent claim 1 is allowable over the combination of cited art for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are

also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejections of claims 1-5 and 9-16 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 **to schedule a Personal Interview**.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Dated: November 28, 2006

Respectfully submitted,

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Attachment(s): English language translation of priority document(s)